511.33114VV5

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Applicants:	HAGIWARA, et al.
Serial No.:	09/482,859
Filed:	January 14, 2000
For:	PATTERN FORMING PROCESS USING PHOTOSENSITIVE RESIN COMPOUND
Group:	1752
Examiner:	John S.Y. Chu

REQUEST FOR RECONSIDERATION

Assistant Commissioner for Patents
Washington, D.C. 20231

October 10, 2002

Sir:

Applicants respectfully submit the following remarks, and enclosed Terminal Disclaimer, in response to the Office Action mailed April 10, 2002, in the above-identified application.

The obviousness-type double patenting rejection over claims 1-11 and 21 of U.S. Patent No. 5,856,059, set forth in the paragraph bridging pages 2 and 3 of the Office Action mailed April 10, 2002, is noted. Enclosed herewith please find a Terminal Disclaimer for the above-identified application, with respect to U.S. Patent No. 5,856,059. It is respectfully submitted that this Terminal Disclaimer is in compliance with 37 CFR 1.321(c). Based upon the presently submitted Terminal Disclaimer, it is respectfully submitted that the obviousness-type double patenting rejection is moot.

It is respectfully submitted that the present filing of this Terminal Disclaimer is

to facilitate proceedings in connection with the above-identified application. It is respectfully submitted that present filing of the enclosed Terminal Disclaimer does not constitute agreement with, or an admission as to the propriety of, the obviousness-type double patenting rejection; and does not constitute agreement with, or an admission as to the propriety of, arguments made by the Examiner in connection with the obviousness-type double patenting rejection.

Accordingly, based upon the filing of the enclosed Terminal Disclaimer, reconsideration and withdrawal of the obviousness-type double patenting rejection are respectfully requested.

The rejection of various of the present claims under 35 USC 102, over the teachings of U.S. Patent No. 5,472,823 to Hagiwara, et al, set forth in Item 5 on pages 3 and 4 of the Office Action mailed April 10, 2002, is respectfully traversed, particularly in view of the following comments. Note that all claims of U.S. Patent No. 5,472,823 to Hagiwara, et al are directed to a photosensitive resin composition including, inter alia, wherein the diamine compound used in forming the poly(amic acid) resin has an -NHCONH-X group (the "X" being a monovalent photosensitive group) at a side chain thereof, as seen in claim 1 of No. 5,472,823.

As can be appreciated, the portions of Hagiwara, et al being relied on by the Examiner in the prior art rejection (that is, Example 13 and Synthesis Example 19 thereof) do not fall within the scope of the subject matter claimed in U.S. Patent No. 5,472,823 to Hagiwara, et al. Thus, it is respectfully submitted that U.S. Patent No. 5,472,823 to Hagiwara, et al does not stand for the proposition that the named inventors in U.S. Patent No. 5,472,823 to Hagiwara, et al invented the subject matter of the present claims, and, moreover, does not stand as evidence for the proposition

that the portions of U.S. Patent No. 5,472,823 to Hagiwara, et al being relied on by the Examiner in the prior art rejection in the Office Action mailed April 10, 2002 (that is, Example 13 and Synthesis Example 19) are the invention of all of the inventors named in U.S. Patent No. 5,472,823 to Hagiwara, et al .

To the contrary, clearly the present Applicants, as established by the Declaration under 37 CFR 1.63 in the above-identified application, show that they are the inventors of the subject matter claimed in the above-identified application, which includes the subject matter of Example 13 and Synthesis Example 19 of U.S. Patent No. 5,472,823 to Hagiwara, et al as applied by the Examiner. Noting common inventors between the above-identified application and U.S. Patent No. 5,472,823 to Hagiwara, et al, and that the U.S. Patent does not establish that the inventors named in U.S. Patent No. 5,472,823 invented the subject matter in the patent being relied upon by the Examiner (that is, the subject matter of Example 13 and Synthesis Example 19), while Applicants in the above-identified application have established (in the Declaration under 37 CFR 1.63) that they are the inventors of the subject matter claimed in the above-identified application, which includes the subject matter being relied upon by the Examiner in the prior art rejection, it is respectfully submitted that the facts of record clearly would lead to a reasonable conclusion that the present Applicants are the inventors of the subject matter disclosed in U.S. Patent No. 5,472,823 and being relied upon in the prior art rejection in the Office Action mailed April 10, 2002. Noting that the above-identified application has an effective filing date of September 2, 1994, while Hagiwara, et al issued (was published) as a U.S. Patent on December 5, 1995 (that is, the U.S. Patent is not available as prior art under 35 USC 102(b)), it is respectfully submitted that the

portion of U.S. Patent No. 5,472,823 to Hagiwara, et al relied upon by the Examiner in the prior art rejection in the Office Action mailed April 10, 2002, does not constitute prior art in connection with the subject matter claimed in the above-identified application (that is, is not prior art under 35 USC 102(e) because it is not the subject matter "of another") .

The Examiner's attention is respectfully directed to Manual of Patent Examining Procedure 716.10, and particularly the paragraph bridging the left- and right-hand columns of page 700-229 of the Manual. It is hereby stated that, regarding the subject matter disclosed in U.S. Patent No. 5,472,823 that is being relied upon by the Examiner in the prior art rejection under 35 USC 102 in the Office Action mailed April 10, 2002 (that is, Example 13 and Synthesis Example 19), only inventors named in the above-identified application developed this subject matter (that is, Example 13 and Synthesis Example 19). Accordingly, and again noting the effective filing date of the above-identified application and issue (publication) date of U.S. Patent No. 5,472,823, it is respectfully submitted that the portion of No. 5,472,823 relied upon in the prior art rejection in the Office Action mailed April 10, 2002, does not constitute prior art in connection with the subject matter presently claimed in the above-identified application. See In re Debaun, 214 USPQ 933 (CCPA 1982).

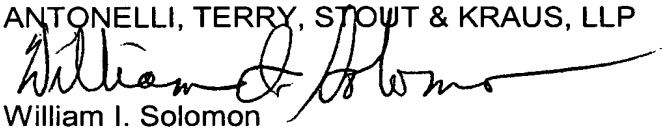
In view of all of the foregoing, reconsideration and allowance of all claims remaining in the application are respectfully requested.

To the extent necessary, Applicants petition for an extension of time under

37 CFR 1.136. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to the Deposit Account No. 01-2135 (Case No. 511.33114VV5), and please credit any excess fees to such Deposit Account.

Respectfully submitted,

ANTONELLI, TERRY, STOUT & KRAUS, LLP



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